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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/055,075 | 01/23/2002 | Mahmoud Torabinejad | D-6901 | 7374 |
| 23377 | 7590 | 03/09/2006 | EXAMINER | |
| WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR 1650 MARKET STREET PHILADELPHIA, PA 19103 | | | JAGOE, DONNA A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1614 | |

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/055,075 | Applicant(s) TORABINEJAD ET AL. | |
| | Examiner Donna Jagoe | Art Unit 1614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-58 and 60-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-58 and 60-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 12, 2005 has been entered.

The amendment filed December 12, 2005 has been received and entered. Claims 34, 47-56, 58, 61, 62, 64, 66, 67, 69, 71, 72, 74, and 75 have been amended and claims 76-80 have been canceled. Claims 34-58 and 60-75 are pending in this application.

Rejection of claims 34-58 under 35 U.S.C. §102(b)/103(a) is no longer maintained in view of the amendment and Declaration submitted December 12, 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 1614

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 34-58 and 60-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Procter & Gamble Co. WO 01/28339 A2.

Procter & Gamble teach an antimicrobial composition comprising an organic acid, the composition having a **pH of from 1 to 7**(see abstract). Citric acid is recited on page 7, line 27. The composition comprises from 0.1 to about 10% of the organic acid (page 7, line 33). Surfactants such as polysorbate 80 are included (see page 22, line 3) in amounts of from 0.1% to about 10% (page 19, lines 20-24). Antimicrobial agents are included such as tetracycline and doxycycline (page 25, lines 29-31) in amounts of from 0.001% to about 10% (page 25, lines 24-28).

It differs in that it does not teach the composition to be sterile. However, the composition of the prior art is employed in, for example, wet wipes suitable for surgical

Art Unit: 1614

preparation wipes. It would be necessarily sterile in order to be employed as a surgical prep wipe.

It does not teach composition in the amounts of 3% disinfectant, 0.5% detergent and 4.25% Acid, however, the amounts recited above overlap and encompass the claimed amounts of disinfectant, detergent and organic acid. Therefore It would have been obvious to one of ordinary skill in art at the time it was made to employ the recited amounts of disinfectant, detergent and organic acid motivated by the teachings of Procter and Gamble comprising a composition of from 0.1 to about 10% of the organic acid (page 7, line 33), a detergent (surfactant) of from 0.1% to about 10% (page 19, lines 20-24) and disinfectant (antimicrobial agent) in amounts of from 0.001% to about 10% (page 25, lines 24-28).

It is further noted that the prior art does not teach the pKa of no greater than 5.

However, the pH of the prior art composition is from 1 to 7. Gleaned from knowledge in the Declaration submitted on December 12, 2005, a composition comprising citric acid as the organic acid with a pKa of 3.128, for example, would have a pH of 2.38 at a concentration of 0.5%. This is within the teachings of Procter and Gamble wherein the concentration of the organic acid is from 0.1 to 10% (page 7, line 33) and the pH is from 1 to 7. It would have been obvious to one of ordinary skill in art at the time it was made to employ at least 0.5% of an organic acid that has a pKa of no greater than 5 motivated by the teaching of Procter and Gamble who teaches a composition comprising an organic acid in an amount of from 0.1 to 10% and a pH of from 1 to 7.

Art Unit: 1614

It is noted that the reference does not teach that the composition can be used in the manner instantly claimed, i.e. for removing a smear layer from a prepared endodontic surface, orthopedic surface and a prepared tooth surface, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Thursday from 9:00 A.M. - 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donna Jagoe
Patent Examiner
Art Unit 1614

March 6, 2006



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